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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,346	12/12/2003	James Harold Gray	02286	3779
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EXAMINER				
PENG, FRED H				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/735,346

**Applicant(s)**

GRAY ET AL.

**Examiner**

FRED PENG

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-18 and 20-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-18 and 20-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "denying local storage of the click stream data at the viewer appliance and, instead" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. Claims 1, 3-18 and 20-32 are pending in this application.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 1 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding Claims 1 and 9, the negative limitations of "denying local storage of the click stream data at the viewer appliance and, instead...." is not the same as "the network capture obtains the click streams without requiring the viewer appliance to capture the click streams and store the click streams for a period of time" as the applicant cited in the specifications (page 5 lines 16-18). Furthermore, nowhere in the specifications discloses these negative limitations; therefore, constitute new matters.

5. Claims 3-8 and 10-17 are also rejected based on the dependency to Claims 1 and 9.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 18 and 20-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matz (US 7,212,979) in view of Ward et al (US 2002/0100064).

Regarding claims 18, 23 and 25, Matz teaches a method of capturing a user command from a viewer that is related to viewing content, comprising: receiving programming from a distribution network at a viewer appliance; receiving the user command and an identifier of a viewer who generated the user command (col. 6, lines 23-44; a record of that click for a viewer is stored in a database inherently including an identifier of a viewer);

establishing communication from the viewer appliance to a remotely located component; capturing the user command and concurrently forwarding the user command from the viewer appliance to the remotely located component (col. 6, lines 26-27); and continuing to store information related to the user command at viewer appliance after the user command has been executed (col. 7, lines 22-25).

Matz discloses noting a time that the user command was received (Col 6 lines 41-44) but is not explicit about by a central switch.

In an analogous art, Ward discloses a router, a central switch, to extract timing information from the network signal and provide this timing information to the remaining studio components (Para 24 lines 18-22). Furthermore, central switch functioning as the user interface at the head end to receive the commands from a user is well known in the art.

Therefore, the design incentive of solving the problem of noting a time that the user command was received would have prompted one of ordinary skill in the art to implement a predictable variation of the prior art system of Matz by applying the known technique of extracting time information at the central switch for distribution, as taught by Ward, to allow the central switch, the user interface, to log in the user commands with time-stamp information at the same time as a logic choice by design.

Regarding claim 20, Matz teaches wherein the reception mechanism and the transfer mechanism are included in a set top box (Fig. 1—124; col. 6, lines 26-30).

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Regarding claim 21, Matz teaches wherein the control mechanism is included in the set top box (Fig. 1--Set-top box 124; col. 6, lines 26-30).

Regarding claim 22, Matz teaches wherein the transfer mechanism concurrently forwards the clickstream data to a video control system located remotely from the premises of the viewer (Fig. 1--Cable Operator Head-end 102; col. 6, lines 26-30).

Regarding claim 24, Matz teaches executing the user command at the premises of the viewer (col. 6, lines 40-44--"channel up" and "channel down").

Regarding claim 26, Matz teaches executing the user command at the viewer appliance to alter an aspect of the content (Col 4 lines 49-51; purchase after viewing the program).

Regarding claim 27, Matz teaches concurrently forwarding the user command comprises concurrently forwarding the user command to a remote storage device (FIG. 1, 122, 112; Col 5 lines 44-52).

Regarding claim 28, Matz teaches matching the user command to a present context (Col 4 lines 49-55; relates a purchase to an advertisement).

Regarding claim 29, Matz teaches determining a result of the user command relative to the present context (Col 4 lines 41-55).

Regarding claim 30, Matz teaches generating targeted advertising based upon information related to the user command (Col 4 lines 41-55).

Regarding claim 31, Matz teaches the user command is concurrently forwarded as the user command is received, thus providing the remotely located component access to the user command (Col 5 lines 44-50; subscriber-action database providing the remotely located component access to the user command).

Regarding claim 32, Matz teaches concurrently forwarding the user command as a control message (Col 7 lines 1-8; program selection is a control message).

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 3-18 and 20-32 have been considered but are moot in view of the new ground(s) of rejection.

#### **In reference to Applicant's arguments**

(a) Matz with Ward thus teaches away. If Matz is combined with Ward, as the Office proposes, then Matz's principle of operation must be impermissibly changed. The patent laws, however, forbid changing a principle of operation to support a prima facie case for obviousness. The § 103 (a) rejection, based on a proposed combination of Matz with Ward, must fail. The Office is required to remove the § 103 (a) rejection of these claims.

#### **Examiner's response**

(a) The Examiner respectfully disagrees with Applicant's arguments. The central switch functions as user interface to receive commands from a user and redirected to a corresponding component in the head end of a cable network is well known in the art. The introduction of the reference of Ward only serves as a prior art to teach a known technique of extracting attached timing information from the received communication data streams. Furthermore, KSR ruling allows the rationale of known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives if the variations are predictable to one of ordinary skill in the art. Therefore, Matz is not required to combine with Ward in order to

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apply the known technique of extracting time information from a communication stream such as time-stamp attached with a user command.

### ***Conclusion***

8. Claims 1, 3-18 and 20-32 are rejected.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Correspondence Information***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRED PENG whose telephone number is (571)270-1147. The examiner can normally be reached on Monday-Friday 09:30-19:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hirl can be reached on (571) 272-3685. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through



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Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fhp

/Joseph P. Hirl/

Supervisory Patent Examiner, Art Unit 2426

November 13, 2009